

67. The gaming device of claim 66 in which indicia symbolizing each of said plurality of video clips and accompanying audios are arranged in an array, the specific video clip and accompanying audio to be played as said entertainment event being selected by a moving member which stops on a particular video clip and accompanying audio for selection thereof.

68. The gaming device of claim 32 in which a plurality of video clips and accompanying audio are available for playing as said entertainment event, and are selectable by the player of the gaming device for playing as said entertainment event.

69. The method of claim 49 in which the motion picture and accompanying audio is selected from a group of said motion pictures and accompanying audios by a generally random process.

70. The method of claim 69 in which indicia symbolizing each alternative motion picture and accompanying audio is arranged in a closed loop array, the specific motion picture and accompanying audio to be played as said entertainment event being selected by a moving member which stops on a particular motion picture and accompanying audio for selection thereof.

71. The method of claim 49 in which the entertainment event comprises a motion picture and accompanying audio selected from a group of said motion pictures and accompanying audios by the player.

REMARKS

Reconsideration of this application and allowance of the claims is respectfully requested.

The amendments to the claims are believed to be clearly supported by the disclosure of this application. For support of the newly added claims, see pages 7-9 of the specification.

No extra claim filing fee is required because nine claims have been canceled in this amendment.

In the last office action of parent application 09/166,483, dated February 27, 2001, the examiner has rejected independent claim 1 and other claims as unpatentable over Weiss 5,919,088 in view of Takemoto et al. 5,913,515, further in view of Pascal 5,971,851.

Weiss discloses a gaming method and apparatus including a simulation of a combination safe. In this invention, a gaming method for a gaming machine is disclosed in which an image of a safe is projected when the player loses, not when there is a winning outcome. Note column 2 of Weiss, lines 40-45: "In a preferred form of the invention, the gradual exposition of the award which inures to the benefit of the player or subsequent players involves the revealing of a combination to a simulative safe, a combination of which is randomly determined and exposed to the player only in a series of successive steps based on successive losses." (Emphasis added)

Accordingly, although Weiss discloses the projection of an image which is additional to the action of a gaming machine, where winning or losing depends upon the numbers in display 28 and not the image of safe 20, the image of the safe is not the display of "an entertainment event comprising a video clip and accompanying audio of a performance in accordance with a first theme of said gaming device...", as called for in claim 1 and other claims.

Also, the audiovisual display of claim 1 is activated "...in response to a winning outcome of said second outcome type..." This is to be contrasted with the activation of the image of the safe in Weiss, which is in response to a losing outcome, not a winning outcome. In addition to the previous citation from Weiss, note column 2, lines 18-27.

Accordingly, substantial distinctions exist between the Weiss patent and the invention of claim 1.

Turning to Takemoto et al., this discloses a game machine with a display device and “special condition” generation.

As shown at column 5, line 57 et. seq., the special condition generator 30 “...comprises a variable prize winning port which is usually kept closed, but intermittently repeats the opening and closing operation a predetermined number of times when a predetermined condition is satisfied during one unit game, specifically, when a score of 1 to 4 points is obtained.”

Basically, under certain conditions in the game, the prize winning port opens, giving the opportunity for the pinball operator to put a pinball through the port for a prize. A display device 20 is also provided. The display device shows a game scene similar to Fig. 3 in the normal state of operation. See column 5, lines 10-17. Then, when the batter of Fig. 3 scores a “hit”, the scene shifts to Fig. 4 “in which the batted ball is followed” (column 5, lines 38-44).

Turning to claim 1, it is not seen that Takemoto et al. uses “an output which indicates a monetary prize amount in response to a winning outcome of said first outcome type...” In this present invention, at least two different kinds of wins can be provided by the game. The first one is a standard winning outcome such as may be found on slot machine reels 114(a, b, c), or another kind of video game. Then, claim 1 also calls for a winning outcome of a second type, distinct from the first outcome type. Specifically, this comprises the desired entertainment event comprising a video clip, specifically relating to an Elvis Presley theme as called for in claims 6 through 8, for example.

Accordingly, it is submitted that claim 1 is not taught by Takemoto et al., or by Weiss, whether considered alone or in combination.

Turning to the Pascal et al. reference applied by the examiner, Pascal et al. shows a system which has an audio/video entertainment capability that comes into use when the gaming machine has a play stoppage, so that the player retains interest in the machine.

This is clearly different from claim 1, which calls for "...an audiovisual display which, in response to a winning outcome of said second outcome type that is distinct from said first outcome type, displays an entertainment event comprising a video clip and accompanying audio of a performance..." What Pascal et al. discloses is an audio/video interlude that steps in when the gaming machine is inoperative. This is of course something substantially different.

Thus, it is submitted that Pascal et al., whether considered alone or in combination with Weiss and Takemoto et al., is not taught by claim 1.

Furthermore, note claim 10, dependent on claim 1, in which an input device is provided which permits the player to select from among a plurality of video clips, for playing when there is a winning outcome of the second outcome type. It is submitted that this is not taught in any of the references cited by the examiner.

Dependent claims 2 through 27, being ultimately dependent upon claim 1, are submitted to be also patentable because of their dependence on claim 1 and also because of their other distinguishing limitations.

The examiner has rejected claim 32 as unpatentable over Weiss, Takemoto et al. and Pascal et al. Claim 32 is similar in various ways to claim 1, having similar distinctions thereto. Note for example the requirement of the "...means for indicating a monetary prize amount in response to a

winning outcome of the first outcome type...” That claim limitation is analogous to a corresponding limitation in claim 1, and provides distinctions over the prior art as specifically described above.

Also, claim 32 calls for “...audio/visual means for, in response to a winning outcome of said second outcome type that is distinct from the first winning outcome type, displaying an entertainment event comprising a video clip and reproducing accompanying audio of a performance in accordance with a first theme of said gaming device as an award...” See the last paragraph of claim 1 for the corresponding limitation.

As the limitations of claim 32 are similar to claim 1, so the distinctions over the prior art are submitted to be similar, as previously discussed. The gaming device of both claims 1 and 32 call for two different kinds of winning outcomes: a first winning outcome of a monetary prize amount, and a second winning outcome of the video clip of the entertainment event, which may also lead to a monetary prize.

This is submitted to be novel, and not disclosed in any of the references cited by the examiner whether alone or in combination.

Note also claim 35, which adds: “...input means for permitting a player to select from among a plurality of video clips...” (When there is a winning outcome of a second outcome type). See also claim 39, in which the video clip displays one or more celebrities or figures appearing in a film sequence from a movie. This also is novel over the prior art.

Accordingly, it is submitted that claim 32, and its dependent claims 33-48, are patentable.

The examiner also rejects claim 49 and other claims on page 4, as unpatentable over Weiss, Takemoto et al., and Pascal.

Claim 49 also calls for a gaming method in which an outcome is determined in a first computer from a group of outcomes which comprise at least first and second winning outcome types. As before, a monetary prize is provided in response to a winning outcome of the first outcome type. An entertainment event is provided in response to a winning outcome of the second outcome type, which type is distinct from the first outcome type and comprises a motion picture and accompanying audio of a musical recording artist song.

Claim 49 and its dependent claims thus have distinctions over the cited prior art which are similar to the distinctions discussed above with respect to claim 1.

Furthermore, in Takemoto et al., the outcome of a round of play is not determined in a first computer, as called for in claim 49. Takemoto et al. discloses a pinball machine, and the outcome of the round of play comprises a ball rolling into a port, particularly a prize-winning port. Accordingly, claim 49 exhibits this added distinction over the prior art.

It is submitted that the prior art does not disclose the concept of the different first and second winning outcome types, particularly in which the second winning outcome type results in the display of part of a motion picture and accompanying audio of a musical recording artist's song, as called for in claim 49.

Dependent claims 50 through 53 are dependent upon claim 49, and thus share in its patentable distinctions. Also, claim 51 calls for "...an input device which permits a player to select from among a plurality of motion pictures..." for playing when the winning outcome of the second type takes place. This is not taught in the cited references.

New dependent claims 63-71 also provide added distinction over the prior art.

The attention of the examiner is directed to the previously filed Information Disclosure Statement, incorporating the references of record in the parent applications. The references should particularly be found in parent application 09/026,060. It is requested that the references be reviewed.


Referring to the rejection of claims 6-8 and 17-18 in the office action and final rejection of February 27, 2001 in the parent application 09/166,483, the examiner objects to the use of the "trademark/tradename Elvis Presley" in the claims.

The claims are not using the trademark. They are referring to the individual, Elvis Presley, who is not a trademark per se but rather an individual, although a trademark of his name exists. Furthermore, while it is believed that applicants have the right to refer to Elvis Presley in a claim, referring specifically to the person, the assignee of this application has a license to use the name Elvis Presley in conjunction with gaming machines.

Accordingly, it is submitted that this rejection should be withdrawn. There is no indefiniteness in the name Elvis Presley. The trademark is really not involved. This situation is different from the typical situation where a trademarked material such as "Acme Soap" might become something different over the years and thus is not descriptive. While it is understandable that a rejection under 35 U.S.C. 112 in that particular situation might hold up, "Elvis Presley" is who he is, and will not change. Thus, the rejection under 35 U.S.C. 112 should be withdrawn.

In view of the above, allowance of the claims is respectfully requested.

Clean copies of the amended claims:

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1. (Amended) A gaming device comprising:
player input wherein a round of play is initiated;

Continued

game output determination wherein an outcome of said round of play includes at least first and second outcome types, wherein said first and second outcome types are winning outcome types;

an output which indicates a monetary prize amount in response to a winning outcome of said first outcome type;

an audiovisual display which, in response to a winning outcome of said second outcome type that is distinct from said first outcome type, displays an entertainment event comprising a video clip and accompanying audio of a performance in accordance with a first theme of said gaming device as an award, wherein said first theme is predetermined.

A2

15. (Amended) A gaming device as claimed in claim 1 wherein said video clip is selected randomly from a group of video clips.

A3

32. (Amended) A gaming device comprising:
player input means for initiating a round of play;
means for determining game outcome wherein an outcome of said round of play includes at least first and second winning outcome types;

means for indicating a monetary prize amount in response to a winning outcome of the first outcome type;

audiovisual means for, in response to a winning outcome of said second outcome type that is distinct from the first winning outcome type, displaying an entertainment event comprising a video clip and reproducing accompanying audio of a performance in accordance with a first theme of said gaming device as an award, wherein said video clip and accompanying audio are selected from a predetermined set of video clips and accompanying audio.

A4

49. (Amended) A computer-implemented gaming method comprising:

receiving player input wherein a round of play is initiated;

determining, in a first computer an outcome of said round of play selected from a group of outcomes comprising at least first and second winning outcome types;

providing a monetary prize in response to a winning outcome of said first outcome type;

providing an entertainment event, in response to a winning outcome of the second type that is distinct from the first outcome type, comprising displaying a motion picture and reproducing an accompanying audio of a musical recording artist's song, wherein said motion picture and accompanying audio are selected from a predetermined set of motion pictures and accompanying audio.

Respectfully submitted,

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